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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,041	12/21/2001	Mary M. DaRif	6962	8619

7590 05/13/2003

The Sherwin-Williams Company
Legal Dept.
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EXAMINER

GREEN, BRIAN

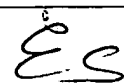
ART UNIT

PAPER NUMBER

3611

DATE MAILED: 05/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicant No. 10/026,041	Applicant(s) DARIF ET AL.	
	Examiner Brian K. Green	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5,6</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I. (claims 1-15) in Paper No. 8 is acknowledged.

Claim Rejections - 35 USC § 112

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 3, there is no antecedent basis for "the dried color". Claim 6 is indefinite since it is not clear whether the name and code are the same as the formula defined in claim 5 or are in addition to the formula. In claim 9, there is no antecedent basis for "the dried color", line 3; "the first colored coating composition". In claim 10, line 3, there is no antecedent basis for "the dried color".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Dohse (U.S. Patent No. 750,620).

Dohse shows in figures 1-3 a paint color card comprising chip sections that are coated with layers of colored compositions (the paint colors white, yellow, orange, etc.) and perforations for

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allowing each of the colored compositions to be separated from the card, see page 1, column 1, lines 41-43. In regard to claim 2, when the colored section B2 is removed from the card a window would be created. In regard to claim 11, one of the sections, for example B2, could be separated along three sides and folded along the fourth side as defined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohse (U.S. Patent No. 750,620).

Dohse discloses the applicant's basic inventive concept except for making the chip sections square. Dohse discloses the idea of making the chip sections rectangular. It would have been an obvious matter of design choice to make the chip sections square since the applicant fails to provide any advantage to making the sections square and the rectangular sections taught by Dohse would work equally well.

Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohse (U.S. Patent No. 750,620) in view of Spangler (U.S. Patent No. 6,270,123) or the applicant's admitted prior art on pages 1 and 2 of the specification.

In regard to claims 4 and 14, Dohse discloses the applicant's basic inventive concept except for making the color card out of paper. Dohse does not disclose what type of material is used to

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make the color card. Spangler discloses in column 6, lines 20-25 the idea of making a color card out of paper. The applicant discloses on page 1 that it is known to make color cards out of paper. In view of the teachings of Spangler or the applicant's admitted prior art it would have been obvious to one in the art to modify Dohse by making the color card out of paper since this would allow the card to be made in an easier and less expensive manner.

Claims 5-7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohse (U.S. Patent No. 750,620) in view of Day et al. (U.S. Patent No. 4,104,809)

In regard to claim 5,6, and 15, Dohse discloses the idea of placing indicia on each chip section to indicate the color of the paint chip but does not disclose placing a formula for the paint color. Day et al. shows in figure 1 the idea of placing indicia for indicating the color of each chip section and indicia for indicating a code/formula for each chip section. In view of the teachings of Day et al. it would have been obvious to one in the art to place the paint formula/code on each of the paint chip sections since this would allow a person to make the desired colored paint in an easier and faster manner. In regard to claim 7, Dohse discloses on page 1, column 2, lines 15-25, the idea of placing a code on the back of each chip section. It would have been obvious to one in the art to modify Dohse by placing the paint formula on the back of each chip section since this would allow the entire color on each of the paint sections to be seen and not be partially obscured by the indicia written thereon.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohse (U.S. Patent No. 750,620) in view of Edwards (U.S. Patent No. 4,992,050).

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Dohse discloses the applicant's basic inventive concept except for placing a color coating on the back of each chip section. Edwards discloses in the abstract the idea of placing a first color of paint on a first side of a chip section and a coating of paint on the opposite side of each chip section. Edwards discloses that the paint on the second side has a different finish as compared to the first side. In view of the teachings of Edwards it would have been obvious to one in the art to modify Dohse by placing a coat of paint on the second surface of each chip section since this would allow more colors/finishes to be displayed by the color card. In regard to claim 9, the colors on each side of the paint chip sections of Edwards are considered to be of the same color but would have different compositions. In regard to claim 8, it is considered within one skilled in art to place the same color on the back of each chip section as on the front since this would allow the color of the paint to be seen on either side of the chip section, i.e. easier and quicker to determine the paint color shown by the color card.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Abramson teaches the use of a color selector card. Lerner et al. teaches the use of a color display device. Cochran et al. teaches the use of a detachable portion.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (703) 308-1011. The examiner can normally be reached on M-F 7am-3:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-4177.


BRIAN K. GREEN
PRIMARY EXAMINER

bkg
May 9, 2003